

**PATENT**

Atty. Dkt. No. ROC920010221US1

MPS Ref. No.: IBMK10221

**REMARKS**

This is intended as a full and complete response to the Final Office Action dated May 20, 2005, having a shortened statutory period for response set to expire on August 20, 2005. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-25 are pending in the application. Claims 1-25 remain pending following entry of this response.

**Claim Rejections - 35 U.S.C. § 102**

Claims 1, 4, 5, 8-11, 14, 17 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by *Mann* (US 6,154,857). Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

In this case, *Mann* does not disclose "each and every element as set forth in the claim". For example, *Mann* does not disclose "automatically counting a number of times each breakpoint in the application is encountered while the application is executing during a test run, wherein the number is increasing and, at any time during the test run, always reflects a current number of times a given breakpoint has been encountered during the test run and wherein counting the number is not limited by a predetermined number representative of a desired number of encounters of the given breakpoint". See, e.g., Claim 1.

The Examiner argues that *Mann* discloses "automatically counting a number of times each breakpoint in the application is encountered while the application is executing during a test run, wherein the number is increasing and, at any time during the test run, always reflects a current number of times a given breakpoint has been

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encountered during the test run and wherein counting the number is not limited by a predetermined number representative of a desired number of encounters of the given breakpoint" at Fig. 2, Item 219b and Col. 13, Line 37 to Col. 14, Line 55. However, the cited portions are in fact directed to a trigger control register used to stop a counter. See Col. 13, Lines 51-55, referring to Fig. 6A.

The trigger control registers 219 are configured to start and stop a counter that measures lapsed time of execution for specified procedures. See Col. 13, Lines 41-42. A first on-chip trigger control register 219a is configured to trigger (start) a first counter upon entry into a specified procedure. See Col. 13, lines 51-60. The second trigger control register 219b is used to stop the counter. *Id.* When the stop trigger is generated as specified by the second trigger control register 219b, the count value of the first counter is placed in the trace cache 200 using a TCODE=1010 trace entry. *Id.* Thus, the counter value placed in the trace cache in *Mann* (where TCODE=1010) describes "a lapsed time of execution for specified procedures". See *id.*; Col. 13, Lines 41-42; Figs. 6A-6B.

*Mann* also describes a second counter. See Col. 13, Line 66 to Col. 14, Line 14. The second counter runs continually, but is reset to zero following a stop trigger event. *Id.* The stop trigger event also causes the value of the second counter to be placed in the trace cache 200. *Id.* Therefore, as described in Fig. 6B, the second counter records the time between stop-trigger events. See *id.*; Fig. 6B; Fig. 6A. This second counter value is useful for obtaining "the frequency of occurrence of a procedure of interest". See Col. 13, Line 66 to Col. 14, Line 14.

As described above, each of the counters in the cited portions of *Mann* record a time. Accordingly, *Mann* does not disclose "automatically counting a number of times each breakpoint in the application is encountered while the application is executing during a test run, wherein the number is increasing and, at any time during the test run, always reflects a current number of times a given breakpoint has been encountered during the test run and wherein counting the number is not limited by a predetermined number representative of a desired number of encounters of the given breakpoint".

Therefore, withdrawal of the rejection is respectfully requested.

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**Claim Rejections - 35 U.S.C. § 103**

Claims 2, 3, 6, 7, 13, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Mann* in view of *Phillips et al.* (US 5,321,828, hereinafter *Phillips*).

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Mann* further in view of *Ishida* (US 5,367,550).

Claims 12 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Mann* in view of *Phillips* further in view of *Peri et al.* (US 6,182,208, hereinafter *Peri*).

Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Mann* in view of *Beckett* (US 4,080,650).

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Mann* in view of *Beckett* further in view of *Phillips*.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over *Mann* in view of *Beckett* further in view of *Peri*.

Applicants respectfully traverse these rejections. Each of the above rejections under 35 U.S.C. § 103(a) incorporate Examiner's 35 U.S.C. § 102 rejection with respect *Mann*. Applicants submit that the additional references cited under 35 U.S.C. § 103(a) do not add substantively with respect to Examiner's 35 U.S.C. § 102 rejection under *Mann*. *Mann* is believed to be overcome for the reasons stated above. Accordingly, each of the rejections under 35 U.S.C. § 103(a) are also believed to be overcome. Withdrawal of the rejections is respectfully requested.

**Conclusion**

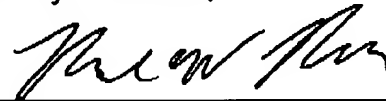
The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to the Applicants' disclosure than the primary references cited in the office action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this office action.

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Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,



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